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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,203	08/09/2000	Satoshi Ogata	13409.1USWO	7904

23552 7590 02/04/2005

MERCHANT & GOULD PC  
P.O. BOX 2903  
MINNEAPOLIS, MN 55402-0903

EXAMINER
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SAVAGE, MATTHEW O

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 02/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/600,203

Applicant(s)

OGATA ET AL.

Examiner

Matthew O Savage

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Prosecution of the application has been re-opened in order to in order to introduce new rejections concerning 35 U.S.C. 112, second paragraph and obvious double patenting.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

On lines 2-3 of claim 7, it is unclear as to whether or not "a perforated cylinder in a twill form" is the same structure that is positively recited on line 4 of claim 1. It is suggested that the limitation be changed to --said perforated cylinder in said twill form--.

On lines 1-2 of claim 8, it is unclear as to what type of pleated matter "the above pleated matter" implies. It is suggested that "the above pleated matter" be changed to --said pleated matter--.

On line 1 of claim 11, it is unclear as to what aspect of the non-woven fabric the "slit width" is associated with. In addition, it is unclear as to what dimension "slit width" implies, i.e., a width of the strip or a width of a slit shaped opening in the strip. It is suggested that --the strip of—be inserted before "the spun" on line 1 to clarify the claim, and that "slit" (two occurrences) be deleted from line 2 of the claim.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4, and 10-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 5, 6, 9, and 14 of copending Application No. 09/837,102. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Instant claim 1 is broad enough to be read upon the combination of claims 2, 5, and 9 of the '102 application;

Instant claims 2, 4, and 11 can be read upon claims 14, 9, and 6, respectively of the '102 application.

Regarding claim 10, the '102 claims fail to specify the recited void rate, however, such a modification would have been obvious in order to optimize the filter for a particular application.

As to claim 12, the '102 claims fail to specify the recited ratio, however, such a modification in filter structure, i.e., selecting the fiber diameter and filter density to achieve such a ratio would have been obvious to one skilled in the art in order to optimize the filter for a particular application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 3 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the combination of claims 2, 5, 9, 14, and 15 of copending Application No. 09/837,102 in view of Pike et al.

The '102 claims fail to specify the low melting point resin as being linear low density polyethylene and the high melting point resin as being polypropylene. Pike et al disclose a spun-bond non-woven filtration fabric formed of a composite fiber linear low density polyethylene and polypropylene (see example 1) and teaches that such a media has high filtration efficiency and high physical strength properties. It would have been obvious to have modified the invention of the '102 claims so as to have included a composite fiber formed of linear low density polyethylene and polypropylene in order to provide a media having high filtration efficiency and high physical strength properties.

This is a provisional obviousness-type double patenting rejection.

Claim 6 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30 and 23 of copending Application No. 09/837,102 in view of JP 4-45811 (see the English translation).

The '102 claims fail to specify the strip as being twisted. The '811 discloses an analogous filter having a strip that is twisted (see lines 12-13 of page 9 of the '811

translation) and that such an arrangement forms a yarn. It would have been obvious to have modified the '102 claimed invention so as to have included a strip that was twisted as suggested by '811 in order to provide a strip in the form of a yarn.

Claims 7-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the combination of claims 2, 5, and of copending Application No. 09/837,102 in view of JP 1-115423.

With respect claim 7, the '102 claims fail to specify pleated matter having 4-50 pleats. J P '423 discloses the concept of pleating an analogous non woven strip 3 so as to have 4-50 pleats (see FIG.6) and suggests that such an arrangement increases the strength and dimensional stability of the filter media (see the abstract). It would have been obvious to the invention of the '102 claims so as to have included pleated matter as suggested by JP '423 in order to increase the strength and dimensional stability of the filter.

Regarding claim 8, JP '423 discloses pleats that are non-parallel because the pleats extend along non-linear paths.

Concerning claim 9, the '102 claims and '423 fail to specify the recited void rate, however, such a modification would have been obvious in order to optimize the filter for a particular application.

This is a provisional obviousness-type double patenting rejection.

Claims 1-4, and 7-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-4, 21-23, 28, and 30 of copending Application No. 09/937,129. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Instant claim 1 is broad enough to be read upon the combination of claims 30 and 23 of the '129 application;

Instant claims 2-4, 7, and 8 can be read upon claims 21-23, 2, and 3 of the '129 application, respectively;

Instant claims 9 and 10 can be read upon claim 4 of the '129 application;

Instant claim 11 can be read upon claim 28 of the '129 application;

As to claim 12, the '102 claims fail to specify the recited ratio, however, such a modification in filter structure, i.e., selecting the fiber diameter and filter density to achieve such a ratio would have been obvious to one skilled in the art in order to optimize the filter for a particular application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 6 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30 and 23 of copending Application No. 09/937,129 in view of JP 4-45811 (see the English translation).

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The '129 claims fail to specify the strip as being twisted. The '811 discloses an analogous filter having a strip that is twisted (see lines 12-13 of page 9 of the '811 translation) and that such an arrangement forms a yarn. It would have been obvious to have modified the '129 claimed invention so as to have included a strip that was twisted as suggested by '811 in order to provide a strip in the form of a yarn.

This is a provisional obviousness-type double patenting rejection.

Claims 1, 2, 4, and 11 are directed to an invention not patentably distinct from claims 2, 5, 6, 9, and 14 of commonly assigned 09/837,102. Specifically:

Instant claim 1 is broad enough to be read upon the combination of claims 2, 5, and 9 of the '102 application;

Instant claims 2, 4, and 11 can be read upon claims 14, 9, and 6, respectively of the '102 application.

Claims 1-4, and 7-11 are directed to an invention not patentably distinct from claims 2-4, 21-23, 28, and 30 of commonly assigned 09/937,129. Specifically:

Instant claim 1 is broad enough to be read upon the combination of claims 30 and 23 of the '129 application;

Instant claims 2-4, 7, and 8 can be read upon claims 21-23, 2, and 3 of the '129 application, respectively;

Instant claims 9 and 10 can be read upon claim 4 of the '129 application;

Instant claim 11 can be read upon claim 28 of the '129 application.



The rejections under 35 U.S.C. 103 set forth in the final office action issued on 7-14-04 have been withdrawn because there was insufficient motivation to combine Japanese Patent 4-45811 (Maedo et al) and U.S. Patent 6,090,731 (Pike et al) since Pike et al taught against compression bonding as recited in instant claim 1 as pointed out in part IV, section A.2. of applicants appeal brief filed on 11-23-04.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O Savage whose telephone number is (571) 272-1146. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*M. Savage*  
Matthew O Savage  
Primary Examiner  
Art Unit 1724

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DUANE SMITH  
PRIMARY EXAMINER

*D-S*  
2-2-05